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10/645,123

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Richard D. Dettinger

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IBM CORPORATION, INTELLECTUAL PROPERTY LAW
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EXAMINER

CHOJNACKI, MELLISSA M

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD D. DETTINGER, CALE T. RATH, and
RICHARD J. STEVENS

Appeal 2009-005094
Application 10/645,123¹
Technology Center 2100

Decided: September 23, 2009

Before HOWARD B. BLANKENSHIP, ST. JOHN COURTENAY, III., and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application filed August 21, 2003. The real party in interest is
International Business Machines Corporation.

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1-7, 18-21, and 30 mailed August 27, 2007, which are all the claims remaining in the application, as claims 8-17 and 22-29 are canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

A. INVENTION

Appellants invented a method and computer readable medium for creating and sharing annotations for query components. (Spec. 25, *see* Abstract.)

B. ILLUSTRATIVE CLAIM

The appeal contains claims 1-7, 18-21, and 30. Claims 1, 18, and 30 are independent claims. Claim 1 is illustrative:

1. A computer implemented method for annotating a query component, the query component being a component of a query, comprising:

receiving a selection of the query component;

receiving an annotation and a request to associate the annotation with the selected query component via an interface allowing a user to create the annotation and request the association with the selected query component; and

storing, on a storage medium, the annotation with a reference to the selected query component.

C. REFERENCE

The sole reference relied upon by the Examiner as evidence in rejecting the claims on appeal is as follows:

Gupta	US 6,956,593 B1	Oct. 18, 2005
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D. REJECTION

The Examiner entered the following rejection which is before us for review:

Claims 1-7, 18-21, and 30 is rejected under 35 U.S.C. § 102(e) as being anticipated by Gupta.

II. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Gupta

1. Gupta discloses “creating, viewing, and temporally positioning annotations for media content.” (Col. 1, ll. 23-24.)
2. Gupta discloses that “[a]dditional search criteria can also be input by the user. . . . Similarly, a summary keyword search field 386 allows particular words, phrases, characters, graphics, etc. that must appear in the summary (or subject, title, annotation content, etc.) to be input.” (Col. 16, ll. 31-37.)

III. PRINCIPLES OF LAW

Under 35 U.S.C. § 102(b), “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc.*

v. Union Oil Co. of Cal., 814 F.2d 628, 631 (Fed. Cir. 1987). Anticipation only requires that the claim at issue “reads on” a prior art reference.

Titanium Metals Corp. of AM. v. Banner, 778 F.2d 775, 781 (Fed. Cir. 1985).

IV. ANALYSIS

The Anticipation Rejection

We now consider the Examiner’s rejection of the claims under 35 U.S.C. § 102(e) as being anticipated by Gupta.

Appellants contend that “*Gupta* is directed to annotating multimedia content and querying such annotations on the multimedia content. Thus, *Gupta* is not directed to annotating the queries components, or even complete queries for that matter, as recited in the claims.” (App. Br. 10.)

Appellants contend that “[a]nnotation query,’ as taught by *Gupta*, is the search (or query) of annotations. In contrast, ‘query annotations,’ is the annotation of queries.” (App. Br. 12.)

Appellants contend that “in *Gupta*, the creation of new annotations is in no way related to the queries being composed in the query dialog box.” (Reply Br. 4.)

The Examiner found:

The Claim language only states that the “query component is a component of a query”, however this is a circular statement and can be interpreted in many ways. The query component can be anything from the query itself to the additional fields that can be selected or filled in, in order to add to the query search, which is a query component and is disclosed in Gupta (See column 16,

lines 31-42). Therefore, the examiner believes that Gupta does in fact disclose creating a new annotation to be associated with a query search.

(Ans. 9.)

Issue: Have Appellants shown that the Examiner erred in finding that Gupta discloses “receiving an annotation and a request to associate the annotation with the selected query component?”

“Our analysis begins with construing the claim limitations at issue.” *Ex Parte Filatov*, No. 2006-1160, 2007 WL 1317144, at *2 (BPAI 2007). We find that the instant case turns on what is a “query component.” Here, Appellants give no clear indication in the Specification as to what is meant by a “query component” but instead merely gives an example of a “query component, e.g., a query condition (Spec. ¶ [0002]). The Examiner found that the claimed query component broadly but reasonably reads on anything from the query itself to additional fields that can add to the query search (Ans. 9). We agree.

We note that although Appellants argue that the claimed invention is directed to annotating the queries components, the Appellants have chosen to draft the claims, claim 1 in particular, far more broadly. Hence, claim 1 broadly reads on an annotation merely being *associated with* the selected query component, not providing a query annotation. An association can be any type of joining or connecting together.

Specifically, Claim 1 recites, *inter alia*, “receiving an annotation and a request to associate the annotation with the selected query component via an interface allowing a user to create the annotation” Here, Gupta

discloses the ability to create annotations via a user interface (FF 1). Gupta further discloses that additional search criteria can be input by the user, including annotation content, when conducting a query (FF 2). Thus, we find that the claimed “receiving an annotation and a request to associate the annotation with the selected query component via an interface” *reads on* Gupta’s ability to input query components along with annotation content during a summary keyword search.

Thus, Appellants have *not* persuaded us of error in the Examiner’s conclusion of anticipation for representative claim 1. Therefore, we affirm the Examiner’s § 102 rejection of independent claim 1 and of claims 2-7, 18-21, and 30, which fall therewith.

V. CONCLUSION

We conclude that Appellants have *not* shown that the Examiner erred in rejecting claims 1-7, 18-21, and 30.

Thus, claims 1-7, 18-21, and 30 are not patentable.

VI. DECISION

In view of the foregoing discussion, we affirm the Examiner’s rejection of claims 1-7, 18-21, and 30.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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